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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,501	05/23/2001	Robert P. Kimberly	UAB-14402/22	9412

7590 12/16/2004

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EXAMINER

SITTON, JEHANNE SOUAYA

ART UNIT PAPER NUMBER

1634

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/807,501

Applicant(s)

KIMBERLY, ROBERT P.

Examiner

Jehanne S Sitton

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE: Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☒ Applicant's reply has overcome the following rejection(s): Rejection under 112/2nd paragraph over claim 1.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 2.

Claim(s) rejected: 1-3,5,7 and 11.

Claim(s) withdrawn from consideration: 4,6,8-10,12-19,21 and 24-32.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Attachment

1. The proposed amendment filed 11/24/2004 will not be entered because the amendment to claim 5 changes the scope of the claims and raises new issues requiring further search and consideration. It is noted that the claims as presently proposed on 11/24/2004 were not indicated by the examiner as allowable in any previous office action or telephonic interview. Additionally, it is noted that the amendment to claim 1 raises issues under 35 USC 112/2nd paragraph as the preamble of the claim and the final step are no longer in agreement.

2. Further, the Declaration filed under 367 CFR 1.132 will not be considered as the filing of this declaration is not considered timely. MPEP 716.01 states:

The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132:

(A) Timeliness. Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to a final rejection,
- (2) before appeal in an application not having a final rejection, or
- (3) after final rejection and submitted
 - (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or
 - (ii) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or
 - (iii) under 37 CFR 1.129(a).

The Declaration by Robert Kimberly addresses issues, general autoimmune disease susceptibility and data presented in the specification with regard to RA and SLE, that were raised in the first office action and is not directed to issues solely raised in the final rejection.

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3. The response's arguments at pages 6-7 with regard to "Specific Polymorphisms and transcription factor binding" and "Metes and bounds of the promoter region" were found persuasive. However, remarks made at the bottom of page 7 "Predictable correlation..." through page 10 will not be considered as they are drawn to issues raised by the Declaration which was not considered timely filed. The claims remain rejected under 112/first paragraph for the reasons made of record in the previous office actions, excluding the issue with regard to position -844 and binding NF-IL6 ("Specific Polymorphisms and transcription factor binding") and the issue with regard to the number system used in claim 1 (and "Metes and bounds of the promoter region"). The response's arguments with regard to the rejection under 112/2nd paragraph over claim 1, are persuasive. Remarks with regard to claims 5 and 11 will not be considered as they are not drawn to the claims presently under examination.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Sitton whose telephone number is (571) 272-0752. The examiner can normally be reached Monday-Thursday from 8:00 AM to 5:00 PM and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jehanne Sitton
Primary Examiner
Art Unit 1634

Jehanne Sitton
12/14/04